

REMARKS

This application has been carefully reviewed in light of the Office Action dated October 17, 2006. Claims 1 to 39, 44, 45, 53 to 58 are in the application, of which Claims 1 and 53 to 58 are independent. Reconsideration and further examination are respectfully requested.

Applicant thanks the Examiner for his withdrawal of the § 101 rejections, which confirms that all claims are directed to statutory subject matter. Claims 42 and 43 have nevertheless been cancelled, without prejudice or disclaimer of subject matter, as explained below.

Claims 40 to 43 have been cancelled, without prejudice or disclaimer of subject matter, and without conceding the correctness of their rejections. This therefore should be viewed as a traversal of these rejections.

The remaining claims were rejected under 35 U.S.C. § 103(a), primarily over U.S. Patent 6,125,390 (Touboul) in view of U.S. Patent Application Publication 2003/0037098 (Niwa)^{1/}. In rejecting certain ones of the dependent claims, the Office Action also relied on U.S. Patent 5,696,701 (Burgess), U.S. Patent 6,456,484 (Hirai) and U.S. Patent 6,167,567 (Chiles). The rejections are all respectfully traversed.

^{1/}The USPTO's reliance on the U.S. published application to Niwa is improper under 35 U.S.C. § 103(c), since Niwa and the subject application are commonly owned by Canon. However, it is understood that Niwa has a published foreign counterpart, at Japan 7-93230, published April 7, 1995. The rejection over Niwa is therefore being addressed on its technological merits.

One basis for traversal is that the Office Action failed to articulate an art-based rationale as to why there is motivation or suggestion to combine Touboul and Niwa. Touboul is directed to a network-based system for monitoring and controlling a program that is capable of being executed on any one of multiple workstations in the network. Touboul nowhere mentions multifunction devices. Niwa, for its part, describes a multifunction device capable of use on a network. The workstations of Touboul are not the same thing as the multifunction device of Niwa, and hence it is not understood how it can be said (at page 4 of the Office Action) that Niwa is “from the same field of endeavor” as Touboul. From Applicant’s perspective, the fields of endeavor are entirely different.

Pages 4 and 5 of the Office Action provide the only explanation as to why there is motivation or suggestion to combine Touboul with Niwa. This explanation is reproduced below. It is Applicant’s position that the explanation does not provide art-based evidence of motivation or suggestion, but rather provides a *post-hoc* rationalization garnered from speculation that is not found anywhere in the cited art:

“Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Touboul in view of Niwa (the modification will be referred to as Touboul from herein on) in order to manage plurality of multifunction network devices such as digital copiers, imaging devices, etc. (Also note that the modification would have been fully compatible because applicant specification suggests that the applicant’s invention can also be used to manage various other types of network devices, not just network printers, see specification, page 35).

“One of ordinary skilled in the art would have been motivated because it would have offered increased flexibility in handling of problems that occur at the multifunction network device (such as printers, workstations, etc., Touboul, col. 1 L55-65). It would have further provided a means for identifying an event occurring with respect to a program

executing on one of the devices, means for sending an alert to the management console, and means for storing plurality of triggers, wherein the triggers are adapted to cause an action to be taken within the network (Touboul, col. 2 L20-37).” (Office Action dated October 17, 2006, pages 4-5).

First and foremost, it is noted that the Office Action’s stated rationale uses Applicant’s own disclosure of the invention. The use of Applicant’s disclosure of his invention, as part of a rationale for obviousness, is a clear contravention of patent law. Page 35 of his disclosure states that “the *invention* can be used to manage various types of network devices...” (emphasis added). MPEP § 2143 is clear in its prohibition against the use of Applicant’s own disclosure, correctly citing to *In re Vaeck*. Withdrawal of the rejection, as improvidently entered on this basis alone, is therefore deemed warranted.

Moreover, even insofar as the Office Action’s stated rationale cited to the disclosures of Touboul and Niwa, the citations do not provide any suggestion or motivation to combine one with the other. In his own words, Touboul monitors and controls a program that is capable of being executed on any one of multiple workstations. Touboul’s definition of a workstation is shown in his Figure 2 and such a definition does not admit of a multifunction device. It is therefore incorrect to state that it would have been obvious to modify Touboul in view of Niwa “in order to manage plurality of multifunction network devices”. In particular, and even though the Office Action mentions digital copiers and imaging devices, Touboul nowhere mentions either one of these devices. Accordingly, the Office Action’s reference to digital copiers and imaging devices is nothing more than *post-hoc* speculation, and does not constitute art-based evidence of suggestion or motivation.

Page 5 of the Office Action states that there would have been motivation to combine because the combination “would have offered increased flexibility in handling of problems...”. This indeed might be an advantage of the combination, but there is no evidence in Touboul or Niwa that either of them recognize such an advantage, or that either of them recognize the means by which such an advantage might be obtained. The Office Action cites to Touboul’s column 1, lines 55 to 65, but those lines only mention workstations, and do not also mention “printers”, as incorrectly stated in the Office Action. Likewise, with respect to the asserted provision of a means for identifying an event, sending an alert and storing a plurality of triggers, neither Touboul nor Niwa mention that such activities might be contemplated with respect to a multifunction device. In this regard, the Office Action’s citation to Touboul’s column 2, lines 20 to 37, mentions only workstations and management consoles, and does not mention multifunction devices.

It is therefore respectfully asserted that a *prima facie* case of obviousness has not been established, since there is no art-based evidence as to why there is motivation or suggestion to combine Touboul and Niwa.

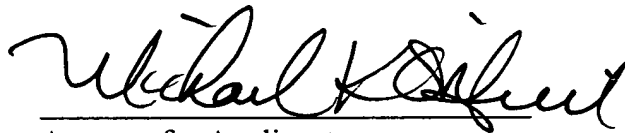
A second basis for traversal is that even if combined, the resulting combination would still fail to disclose or suggest the claimed invention. Neither Touboul nor Niwa describes has a reconfiguration that can restore programs from a multifunction network device to an information processing apparatus, in a case where hardware resources in the multifunction device decrease. Likewise, neither Touboul nor Niwa describes a reconfiguration to retrieve programs from the information processing apparatus to the

multifunction device, in a case where the hardware resources in the multifunction device increases.

It is therefore respectfully submitted that the claims herein recite subject matter that would not have been obvious from any permissible combination of the applied art, and allowance of all claims is respectfully requested.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", is written over a horizontal line.

Attorney for Applicant
Michael K. O'Neill
Registration No.: 32,622

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

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